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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049146
Party	Plaintiff Arcadia Group Brands Limited
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Attachments	Petitioner's Resp to Cross-Mot and Alt Mot, and Reply in Support of Petitioner's Mot.PDF ( 22 pages )(918954 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Arcadia Group Brands Ltd.,	)	
	)	
Petitioner,	)	Cancellation No. 92049146
	)	
v.	)	
	)	
Studio Moderna SA,	)	
	)	
Registrant.	)	
	)	

**PETITIONER’S RESPONSE IN OPPOSITION TO STUDIO MODERNA’S CROSS  
MOTION TO SUSPEND AND ALTERNATIVE MOTION TO STRIKE; AND REPLY IN  
SUPPORT OF PETITIONER’S MOTION TO CONSOLIDATE**

Petitioner Arcadia Group Brands Ltd. (“Arcadia”), by and through its attorneys, hereby submits its response in opposition to Registrant Studio Moderna SA’s (“Registrant” or “Studio Moderna”) Cross Motion to Suspend Pending Outcome of Opposition No. 91169226 and Alternative Motion to Strike Paragraphs 8-11 of Petitioner’s Amended Petition to Cancel, and Arcadia’s reply in support of its Motion to Consolidate. In support of Arcadia’s Motion to Consolidate, and in Opposition to Registrant’s Motion to Suspend and Alternative Motion to Strike, Arcadia states as follows:

**INTRODUCTION**

On April 7, 2008, Arcadia filed a petition to cancel Registrant’s registration for the mark TOP SHOP TV (Registration No. 3,389,652), and an amended petition on May 6, 2008.

The parties to this cancellation proceeding are also involved in a related Board proceeding, Opposition No. 91169226, where Arcadia is opposing Registrant’s application for the mark TOP SHOP TV & Design (Serial No. 78/239,078) (hereinafter, the “Opposition Proceeding”). Because the two proceedings involve the same parties, marks which contain

identical terms that are therefore substantially related, and common issues of law and fact, Arcadia filed a Notice of Related Proceedings on April 25, 2008 to notify the Board of Opposition No. 91169226, in accordance with the Trademark Trial and Appeal Board's (the "Board") letter to Mr. Mitchell P. Brook and Mr. Floyd Mandell. (See Letter from Board, dated April 8, 2008, attached hereto as Exhibit 1 ("If the parties to this proceeding are ... parties in another Board proceeding or a civil action involving related marks or other issues of law or fact which overlap with this case, they shall notify the Board immediately...").) The Board subsequently converted Arcadia's Notice of Related Proceedings into a Motion to Consolidate.

On May 23, 2008, Registrant filed its response in opposition to Arcadia's Motion to Consolidate, and filed a Cross Motion to Suspend the Cancellation Proceeding Pending Outcome of Opposition No. 91169226 and Alternative Motion to Strike Paragraphs 8-11 of Arcadia's Amended Petition to Cancel ("Registrant's Response").

Because consolidation of this cancellation proceeding and the Opposition Proceeding will avoid duplication of effort concerning the factual and legal issues in common in both proceedings, and will avoid unnecessary costs and delays, the Board should grant Arcadia's Motion to Consolidate and deny Registrant's Cross Motion to Suspend. This is especially true where, as here, discovery in the related proceeding has not been concluded and no depositions have yet been taken. Moreover, because the parties to these proceedings are both international, consolidating the deposition schedule in these related proceedings will save even more time and expense.

In addition, the Board should deny Registrant's Alternative Motion to Strike Paragraphs 8-11 of Arcadia's Amended Petition to Cancel, as the alternative motion is not a proper Rule 12(f) motion.

## ARGUMENT

### **I. Legal Standard.**

Pursuant to Federal Rule of Civil Procedure 42(a) and TBMP 511, when cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of cases. *See S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997). In determining whether to consolidate proceedings, the Board must weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby. (TBMP 511); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975).

With regard to Registrant's alternative motion to strike, in order to strike any portions of a pleading, the movant must show that portions of a pleading are "redundant, immaterial, impertinent or scandalous." (*See* Fed. R. Civ. P. 12(f); TBMP 506.01.) However, motions to strike are not favored, and a matter will not be stricken unless it clearly has no bearing upon the issues in the case. (TBMP 506.01); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401 (TTAB 1973). Furthermore, because the primary purpose of a pleading is to give fair notice of the claims or defenses asserted, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *Id.*

### **II. The Board Should Consolidate The Two Related Proceedings, And Should Not Suspend This Cancellation Proceeding.**

#### **A. The proceedings involve commons questions of law and fact, and should be consolidated.**

In this cancellation proceeding, Arcadia seeks to cancel Registrant's registration for the mark TOP SHOP TV (Registration No. 3,389,652). Similarly, in the Opposition Proceeding,

Arcadia opposes Registrant's application for the mark TOP SHOP TV & Design (Serial No. 78/239,078). The parties – Arcadia Group Brands Ltd. and Studio Modern SA – are the same in this cancellation proceeding and in the Opposition Proceeding. The marks – TOP SHOP TV and TOP SHOP TV & Design – are virtually identical.

Moreover, there are common issues of law and fact in this cancellation proceeding and in the Opposition Proceeding. For instance, in both proceedings the Board would need to determine, among other things, whether Arcadia's use of the TOP SHOP mark in commerce predates Registrant's use; whether Arcadia has superior rights in its TOP SHOP mark; whether Registrant's registration and application of the marks at issue in retail services would likely confuse consumers; and whether the agreement between Arcadia and Registrant bars the Registrant from using the marks at issue for retail services that market clothing and related goods.

Registrant itself admits that the Opposition Proceeding and this cancellation proceeding “involve overlapping ... issues of law and fact.” (Registrant's Response at 3.) Indeed, in its Response, Registrant cites to at least four overlapping issues between the Opposition Proceeding and this cancellation proceeding. (Registrant's Response at 3 (admitting that the parties are identical, the marks contain the same words, the proceedings involve the common question of whether Arcadia has trademark rights in the U.S. baring registration in class 35, and Arcadia's allegation that an agreement between the parties prevent Registrant from applying for the marks at issue for services in Class 35).)

The minor differences between the proceedings that Registrant highlights in its Cross-Motion are patently insufficient to overcome the facts supporting consolidation. For instance, Registrant alleges that the mark at issue in the Opposition Proceeding contains a design element

that the mark at issue in this cancellation proceeding does not, and that the services at issue in the two proceedings are not identical (Registrant's Response at 4), but the Board regularly consolidates proceedings in which such minor variations are present. *See, e.g., Ritchie v. Simpson*, 41 USPQ2d 1859 (TTAB 1996), rev'd on other grounds, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (cases consolidated despite variations in marks and goods).

Registrant's argument that there should be no consolidation of the proceedings because the mark in the Opposition Proceeding involves an intent to use application and the mark in this cancellation proceeding involves a registered mark is similarly meritless, as the Board often consolidates opposition and cancellation proceedings involving similar facts. *See, e.g., Hilson Research Inc. v. Society for Human Resources Management*, 27 USPQ2d 1423 (TTAB 1993); *8440 LLC v. Midnight Oil Company*, 59 USPQ2d 1541 (TTAB 2001) (opposition and cancellation consolidated).

Accordingly, because this cancellation proceeding and the Opposition Proceeding involve common questions of law and fact, the same parties, and a virtually identical mark, the proceedings should be consolidated.

**B. The savings in time, effort, and expense by consolidation outweigh any prejudice or inconvenience consolidation may cause.**

Consolidation of this cancellation proceeding with the Opposition Proceeding will avoid duplication of effort concerning the factual and legal issues in common and will thereby avoid unnecessary costs and delays. For instance, the parties have already exchanged certain written discovery in the Opposition Proceeding, all of which is relevant to this action. If the two proceedings are consolidated, the parties may use the discovery already served and answered as evidence in the consolidated proceeding. Moreover, because the written discovery deadline has not yet passed, any additional written discovery associated with this proceeding may proceed

without delay of the other proceeding. And, because the parties are non-U.S. based entities, and depositions have not proceeded in either case, consolidation will avoid duplicative and expensive international depositions. Instances of inconsistent rulings on same or similar issues will also be avoided if the proceedings are consolidated.

On the other hand, Registrant fails to show that consolidation of the proceedings will cause it prejudice or inconvenience. In a footnote in its Response, Registrant claims that “[t]o the extent Petitioner tries to create new issue and inject them into this Cancellation, entirely new rounds of discovery rehashing the now familiar facts underlying this dispute would have to start from scratch.” (Registrant’s Response at 5, n. 3.) This is not true. Because the two proceedings involve common issues of law and fact, if the proceedings are consolidated, the parties would at most need to supplement their already exchanged discovery to address any alleged new issues.

Accordingly, because the savings in time, effort, and expense by consolidation far outweigh any prejudice or inconvenience consolidation may cause, the proceedings should be consolidated.

**C. This cancellation proceeding should not be suspended.**

For the same reasons discussed above, this cancellation proceeding should be consolidated with the Opposition Proceeding pursuant to Rule 42(a). It should not be suspended. Indeed, Registrant’s request for a suspension is a tacit admission that the two proceedings are closely related, a further factor in favor of consolidation.

Registrant argues in its Response that that the “most efficient way to resolve the issues in this proceeding is to suspend the Cancellation pending resolution of the Opposition” and that “it is likely disposition of the Opposition will lead to a resolution of the Cancellation.” (Registrant’s Opposition at 2-3.) However, if this cancellation proceeding is suspended, upon

resolution of the Opposition Proceeding, the parties would be required to delve into further litigation over many of the same issues and facts, and would most likely be required to, among other things, re-exchange discovery and re-take the depositions of foreign witnesses.

To support a suspension of this cancellation proceeding, Registrant claims that “the Opposition is well on its way toward a final decision.” (Registrant’s Response at 5.) This is not true. In fact, the Opposition Proceeding has been suspended pending the disposition of Arcadia’s motion to compel and Arcadia’s motion to take the oral deposition of a Fed. R. Civ. P. 30(b)(6) representative of Registrant in Switzerland. (*See* Interlocutory Attorney Order Suspending Proceeding, dated September 19, 2007, attached hereto as Exhibit 2.) Thus, discovery is still open in the Opposition Proceeding, the production of certain documents and information is still outstanding, and no depositions – written or oral – have yet to take place. As discussed above, if this cancellation proceeding is suspended, upon resolution of the Opposition Proceeding, the parties would have to recreate the wheel for this cancellation proceeding – which would generate unnecessary costs and delays for the Board and both parties.

Accordingly, the Board should not suspend this cancellation proceeding, and should instead consolidate the proceedings in order to avoid duplication of effort concerning the factual and legal issue in common and to avoid unnecessary costs and delays.

**III. The Board Should Deny Registrant’s Alternative Motion To Strike Because Paragraphs 8 Through 11 of Arcadia’s Amended Petition Are Not Redundant, Immaterial, Impertinent, Or Scandalous, And Their Inclusion Will Not Prejudice Registrant.**

Registrant’s alternative motion to strike should be denied because Registrant has not met its burden under Rule 12(f) to demonstrate that paragraphs 8 through 11 of Arcadia’s Amended Petition to Cancel are “redundant, immaterial, impertinent or scandalous.” Moreover, the Board should not strike paragraphs 8 through 11 of Arcadia’s Amended Petition to Cancel because they



bear upon the issues in the proceedings, and Registrant cannot show prejudice. (*See* TBMP 506.01); *see also*, *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401 (TTAB 1973).

In Paragraphs 8 through 10 of Arcadia's Petition to Cancel, Arcadia argues that Registrant is barred from seeking the requested registration by the terms of the parties' coexistence agreement, and the understanding of the parties when they entered into such agreement. Registrant argues these allegations are redundant of an argument raised by Arcadia in the Opposition Proceeding and thus should be stricken. Registrant's position is both factually and legally misguided and cannot support a motion to strike.

On April 26, 2007, the Board entered partial summary judgment against Arcadia in the Opposition Proceeding, finding that the coexistence agreement did not bar Registrant's application because Registrant was not at the time selling Class 25 goods marketed under the mark at issue through retail services. (Registrant's Response, Ex. A Summary Judgment Decision at 5 (finding that Arcadia had not submitted evidence which demonstrated that Registrant sells Class 25 goods through its retail serves, and that there is no evidence which shows that the goods themselves are marketed under the TOP SHOP mark).) As set forth above, the Opposition Proceeding remains pending and discovery has yet to be completed.

During discovery in the Opposition Proceeding and through investigation, however, Arcadia has confirmed that Registrant actually has been marketing Class 25 goods in its retail services under the mark at issue. Thus, the circumstances are vastly changed from April 26, 2007, when the Court considered the issue in its interim order. Moreover, contrary to Registrant's argument, it is abundantly apparent that Arcadia is not seeking to have the Board

“consider the same allegations all over again.” (*See* Registrant’s Response at 6.) There are new facts to be considered.

Furthermore, issue preclusion has no application to paragraphs 8 through 10 of Arcadia’s Amended Petition to Cancel because, among other things, the Board’s summary judgment decision is an interim order and thus not final. As set forth above, the Opposition Proceeding in which the ruling was made is still proceeding and thus no final order, a prerequisite to issue preclusion, exists. Fed. R. Civ. P. 54(b) (any order, regardless of how designated, that does not end the action as to any of the claims or parties “may be revised at any time”); *Vardon Gold Co., Inc. v. Karsten Manufacturing Corp.*, 294 F.3d 1330, 1334 (Fed. Cir. 2002) (finding that partial summary judgment rendered in a prior suit did not collaterally estopp patentee from asserting same claims in second suit where the partial summary judgment was interlocutory, never certified under Rule 54(b), and therefore not “final” for collateral estoppel purposes.) Indeed, Arcadia would have been remiss not to raise the issue of this coexistence agreement in this related proceeding.

Registrant’s motion to strike on the grounds that certain statements made by Arcadia are “immaterial or impertinent” (Registrant’s Response at 8-10) is also baseless. For instance, Arcadia has alleged that “the documents produced by Registrant in the Related Opposition reveal that Registrant is marketing articles of clothing, footwear and other Class 25 goods under the TOP SHOP name and mark.” (Amended Petition to Cancel ¶10). This allegation relates directly to Arcadia’s claim that Registrant’s use and registration of the TOP SHOP TV mark in International Class 35 can be construed to include articles of clothing, footwear and headgear, and therefore violates the spirit and the terms set forth in the coexistence agreement between the parties. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988)

(since function of pleadings is to give fair notice of claim, a party is allowed reasonable latitude in its statement of its claims).

Additionally, Registrant also finds fault with paragraph 11 in Arcadia's Amended Petition to Cancel. In paragraph 11, Arcadia asserts that Registrant filed two new applications in the USPTO for the marks TOP SHOP and TOP SHOP TV for, among other things, retail services, even though Registrant was fully aware of Arcadia's use of the mark TOP SHOP for online retail services in the United States since 1998. Registrant claims that the matters alleged in paragraph 11 are scandalous, immaterial, and impertinent to the issues in this cancellation proceeding. (Registrant's Response at 8-10.) On the contrary, Paragraph 11 of Arcadia's Amended Petition to Cancel is directly relevant to Registrant's intent to register the mark at issue and bears upon Arcadia's claim that Registrant's mark so resembles Arcadia's mark that, when used on or in connection with the services of Registrant, it is likely to cause confusion, cause mistake, or deceive. Accordingly, paragraph 11 is also relevant to Arcadia's claims, and should not be stricken from its Amended Petition. (*See* TBMP 506 ("matter will not be stricken unless it clearly has no bearing upon the issues in the case"); *see also, Leon Shaffer*, 177 USPQ 401.)

In sum, none of the allegations of Arcadia's Amended Petition to Cancel are redundant, immaterial, impertinent, or scandalous, and thus none should be stricken.

Even if the argument could be raised that paragraphs 8 through 11 of Arcadia's Amended Petition to Cancel are redundant, immaterial, impertinent, or scandalous, there is no evidence to suggest that Registrant will be prejudiced by the inclusion of such paragraphs in Arcadia's Amended Petition to Cancel. In such circumstances, the Board should decline to strike even objectionable matters in a pleading, as motions to strike are a disfavored remedy. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (since purpose of pleadings

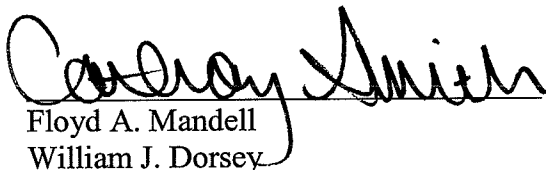
is to give fair notice of claims, Board may in its discretion decline to strike even objectionable pleadings where their inclusion will not prejudice adverse party but rather will provide fuller notice of basis for claim). Accordingly, paragraphs 8 through 11 of Arcadia's Amended Petition to Cancel should not be stricken.

WHEREFORE, for all the reasons set forth herein and in Petitioner Arcadia Group Brands Ltd.'s Motion to Consolidate, Arcadia respectfully requests that the Board grant Arcadia's Motion to Consolidate, and issue an order consolidating Cancellation No. 92049146 and Opposition No. 91169226, and deny Registrant Studio Moderna's Cross-Motion to Suspend and Alternative Motion to Strike Paragraphs 8-11 of Petitioner's Amended Petition to Cancel.

Respectfully submitted,

**Attorney for Petitioner,  
Arcadia Group Brands Ltd.**

Date: June 12, 2008

A handwritten signature in black ink, appearing to read "Cathay Y. N. Smith", is written over a horizontal line.

Floyd A. Mandell  
William J. Dorsey  
Cathay Y. N. Smith  
KATTEN MUCHIN ROSENMAN LLP  
525 West Monroe Street  
Chicago, Illinois 60661-3693  
Telephone: (312) 902-5200  
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# Exhibit 1

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: April 8, 2008

Cancellation No. **92049146**  
Registration No. 3389652

Mitchell P. Brook  
Luce, Forward, Hamilton & Scripps LLP  
11988 El Camino Real, Ste 200,  
San Diego, CA 92130 UNITED STATES

Arcadia Group Brands Limited

v.

Studio Moderna SA

Floyd Mandell  
Katten Muchin Rosenman LLP  
525 West Monroe Street,  
Chicago, IL 60661 UNITED STATES

Karl Kochersperger, Paralegal

**A petition to cancel the above-identified registration has been filed.** A service copy of the petition for cancellation was forwarded to registrant (defendant) by the petitioner (plaintiff). An electronic version of the petition for cancellation is viewable in the electronic file for this proceeding via the Board's TTABVUE system:  
**<http://ttabvue.uspto.gov/ttabvue/>**.

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations ("Trademark Rules"). These rules may be viewed at the USPTO's trademarks page: **<http://www.uspto.gov/main/trademarks.htm>**. The Board's main webpage (**<http://www.uspto.gov/web/offices/dcom/ttab/>**) includes information on amendments to the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to the Board's manual of procedure (the TBMP).

In the involved registration, registrant has designated Mitchell P. Brook of Luce, Forward, Hamilton & Scripps LLP as its representative in the United States on whom may be served notices affecting this registration. If the registrant chooses to be represented by counsel in this proceeding, a power of attorney to that effect may be filed, or registrant's chosen counsel may simply make an appearance pursuant to Trademark Rule 2.17. Registrant's copy of any communication from the Board will be sent to registrant's domestic representative until counsel is appointed or makes an appearance on behalf of registrant. See Trademark Rule 2.119(d).

Plaintiff must notify the Board when service has been ineffective, within 10 days of the date of receipt of a returned service copy or the date on which plaintiff learns that service has been ineffective. Plaintiff has no subsequent duty to investigate the defendant's whereabouts, but if plaintiff by its own voluntary investigation or through any other means discovers a newer correspondence address for the defendant, then such address must be provided to the Board. Likewise, if by voluntary investigation or other means the plaintiff discovers information indicating that a different party may have an interest in defending the case, such information must be provided to the Board. The Board will then effect service, by publication in the Official Gazette if necessary. See Trademark Rule 2.118. In circumstances involving ineffective service or return of defendant's copy of the Board's institution order, the Board may issue an order noting the proper defendant and address to be used for serving that party.

Defendant's ANSWER IS DUE FORTY DAYS after the mailing date of this order. (See Patent and Trademark Rule 1.7 for expiration of this or any deadline falling on a Saturday, Sunday or federal holiday.) Other deadlines the parties must docket or calendar are either set forth below (if you are reading a mailed paper copy of this order) or are included in the electronic copy of this institution order viewable in the Board's TTABVue system at the following web address: <http://ttabvue.uspto.gov/ttabvue/>.

Defendant's answer and any other filing made by any party must include proof of service. See Trademark Rule 2.119. If they agree to, the parties may utilize electronic means, e.g., e-mail or fax, during the proceeding for forwarding of service copies. See Trademark Rule 2.119(b)(6).

The parties also are referred in particular to Trademark Rule 2.126, which pertains to the form of submissions. Paper submissions, including but not limited to exhibits and transcripts of depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Time to Answer	5/18/08
Deadline for Discovery Conference	6/17/08
Discovery Opens	6/17/08
Initial Disclosures Due	7/17/08
Expert Disclosures Due	11/14/08
Discovery Closes	12/14/08
Plaintiff's Pretrial Disclosures	1/28/09
Plaintiff's 30-day Trial Period Ends	3/14/09
Defendant's Pretrial Disclosures	3/29/09
Defendant's 30-day Trial Period Ends	5/13/09
Plaintiff's Rebuttal Disclosures	5/28/09
Plaintiff's 15-day Rebuttal Period Ends	6/27/09

As noted in the schedule of dates for this case, the parties are required to have a conference to discuss: (1) the nature of and basis for their respective claims and defenses, (2) the possibility of settling the case or at least narrowing the scope of claims or defenses,

and (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case. See Trademark Rule 2.120(a)(2). Discussion of the first two of these three subjects should include a discussion of whether the parties wish to seek mediation, arbitration or some other means for resolving their dispute. Discussion of the third subject should include a discussion of whether the Board's Accelerated Case Resolution (ACR) process may be a more efficient and economical means of trying the involved claims and defenses. Information on the ACR process is available at the Board's main webpage. Finally, if the parties choose to proceed with the disclosure, discovery and trial procedures that govern this case and which are set out in the Trademark Rules and Federal Rules of Civil Procedure, then they must discuss whether to alter or amend any such procedures, and whether to alter or amend the Standard Protective Order (further discussed below). Discussion of alterations or amendments of otherwise prescribed procedures can include discussion of limitations on disclosures or discovery, willingness to enter into stipulations of fact, and willingness to enter into stipulations regarding more efficient options for introducing at trial information or material obtained through disclosures or discovery.

The parties are required to conference in person, by telephone, or by any other means on which they may agree. A Board interlocutory attorney or administrative trademark judge will participate in the conference, upon request of any party, provided that such participation is requested no later than ten (10) days prior to the deadline for the conference. See Trademark Rule 2.120(a)(2). The request for Board participation must be made through the Electronic System for Trademark Trials and Appeals (ESTTA) or by telephone call to the interlocutory attorney assigned to the case, whose name can be found by referencing the TTABVue record for this case at <http://ttabvue.uspto.gov/ttabvue/>. The parties should contact the assigned interlocutory attorney or file a request for Board participation through ESTTA only after the parties have agreed on possible dates and times for their conference. Subsequent participation of a Board attorney or judge in the conference will be by telephone and the parties shall place the call at the agreed date and time, in the absence of other arrangements made with the assigned interlocutory attorney.

The Board's Standard Protective Order is applicable to this case, but the parties may agree to supplement that standard order or substitute a protective agreement of their choosing, subject to approval by the Board. The standard order is available for viewing at: <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>. Any party without access to the web may request a hard copy of the standard order from the Board. The standard order does not automatically protect a party's confidential information and its provisions must be utilized as needed by the parties. See Trademark Rule 2.116(g).

Information about the discovery phase of the Board proceeding is available in chapter 400 of the TBMP. By virtue of amendments to the Trademark Rules effective November 1, 2007, the initial disclosures and expert disclosures scheduled during the discovery phase are required only in cases commenced on or after that date. The TBMP has not yet been amended to include information on these disclosures and the parties are referred to the August 1, 2007 Notice of Final Rulemaking (72 Fed. Reg. 42242) posted on the Board's webpage. The deadlines for pretrial disclosures included in the trial phase of the schedule for this case



also resulted from the referenced amendments to the Trademark Rules, and also are discussed in the Notice of Final Rulemaking.

The parties must note that the Board allows them to utilize telephone conferences to discuss or resolve a wide range of interlocutory matters that may arise during this case. In addition, the assigned interlocutory attorney has discretion to require the parties to participate in a telephone conference to resolve matters of concern to the Board. See TBMP § 502.06(a) (2d ed. rev. 2004).

The TBMP includes information on the introduction of evidence during the trial phase of the case, including by notice of reliance and by taking of testimony from witnesses. See TBMP §§ 703 and 704. Any notice of reliance must be filed during the filing party's assigned testimony period, with a copy served on all other parties. Any testimony of a witness must be both noticed and taken during the party's testimony period. A party that has taken testimony must serve on any adverse party a copy of the transcript of such testimony, together with copies of any exhibits introduced during the testimony, within thirty (30) days after the completion of the testimony deposition. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing after briefing is not required but will be scheduled upon request of any party, as provided by Trademark Rule 2.129.

If the parties to this proceeding are (or during the pendency of this proceeding become) parties in another Board proceeding or a civil action involving related marks or other issues of law or fact which overlap with this case, they shall notify the Board immediately, so that the Board can consider whether consolidation or suspension of proceedings is appropriate.

**ESTTA NOTE:** For faster handling of all papers the parties need to file with the Board, the Board strongly encourages use of electronic filing through the Electronic System for Trademark Trials and Appeals (ESTTA). Various electronic filing forms, some of which may be used as is, and others which may require attachments, are available at <http://estta.uspto.gov>.

# Exhibit 2

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Lykos

Mailed: September 19, 2007

Opposition No. 91169226

Arcadia Group Brands Ltd

v.

Studio Moderna SA

Angela Lykos, Interlocutory Attorney

On September 5, 2007, opposer filed a motion to compel with the request that the Board resolve the motion via telephone conference. A telephone conference was held on Wednesday, September 19, 2007 at 2 PM EST among William J. Dorsey and Cathay Smith, counsel for opposer, Mitchell P. Brook and Aaron Winn, counsel for applicant, and the undersigned, as the Board attorney responsible for resolving interlocutory disputes in this proceeding. Currently pending before the Board are (1) opposer's motion to compel supplemental responses to opposer's first set of interrogatories and document production requests, and (2) opposer's motion (filed August 21, 2007) to take the oral deposition of a Fed. R. Civ. P. 30(b)(6) representative of applicant in Switzerland.

During the telephone conference, applicant indicated that it would be providing supplemental responses to opposer's outstanding discovery requests, and therefore requested additional time to respond to opposer's motion to compel. Opposer objected on the grounds that it would constitute undue delay.

The appropriate standard for allowing an extension of a prescribed period prior to the expiration of the time period is "good cause." See Fed. R. Civ. P. 6(b) and TBMP § 509 (2d ed. rev. 2004) and authorities cited therein. The Board generally is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. See, e.g., *American Vitamin Products Inc., v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992); and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985).

We find that applicant has demonstrated the requisite good cause to warrant an extension of time. Applicant indicated that it intends to supplement its responses to the discovery requests in a manner that would resolve many of the issues raised in opposer's motion to compel.

In view thereof, applicant's motion to extend is granted. Applicant is allowed until September 27, 2007 to respond to opposer's motion to compel, failing which the

motion will be granted as conceded. See Trademark Rule 2.127(a).

The Board has reviewed opposer's pending motion to compel, and in the interest of facilitating the orderly proceeding of this case, reminds applicant that any supplemental responses should conform with the following:

- Fed. R. Civ. P. 26(b)(5), made applicable to Board proceedings by Trademark Rule 2.116(a), provides that where a claim of privilege is invoked, a party must make the claim expressly and provide a description or privilege log of the documents, communications or things not disclosed in such a manner that will enable other parties to assess the applicability of the privilege or protection.

- On August 15, 2007, the Board approved the parties' stipulated protective order governing the disclosure of confidential information. The agreement therefore obviates the need for objections based on confidentiality.

- Answers to interrogatories must be accompanied by a signed certification. See Fed. R. Civ. P. 33(a)(2). In cases where the party is a corporation, an officer or agent of the corporation must answer the interrogatories. See Fed. R. Civ. P. 33(a) and (b).

Proceedings herein are suspended pending disposition of opposer's motion to compel and opposer's motion to take the oral deposition of a Fed. R. Civ. P. 30(b)(6) representative of applicant in Switzerland, except as discussed below.<sup>1</sup>

The parties should not file any paper which is not germane

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<sup>1</sup> The parties' consented motion (filed August 29, 2007) to extend the close of discovery and trial dates is hereby approved.

to the motion to compel. See Trademark Rule 2.120(e)(2), as amended effective October 9, 1998.<sup>2</sup>

This suspension order does **not** toll the time for either party to respond to discovery requests which had been duly served prior to the filing of the motion to compel, nor does it toll the time for a party to appear for a discovery deposition which had been duly noticed prior to the filing of the motion to compel. See *Id.*

However, as discussed and agreed upon by parties during the telephone conference, the previously noticed depositions on written questions scheduled to take place on September 29, 2007 are hereby postponed. Following the Board's ruling on the pending motions, the Board will provide a time frame for the parties to agree on the rescheduling of any depositions on written questions.

As discussed during the telephone conference, the pending motions will be decided in due course via written Board order.

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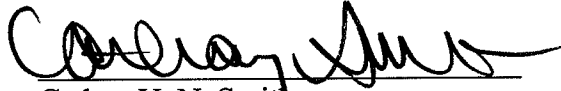
<sup>2</sup> See Notice of Final Rulemaking published in the *Federal Register* on September 9, 1998 at 63 FR 48081 and in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. A copy of the recent amendments to the Trademark Rules, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

**CERTIFICATE OF SERVICE**

I hereby certify that I have caused a true and correct copy of the foregoing to be served upon:

Mitchell P. Brook, Esq.  
Andrea M. Kimball  
Eric L. Lane  
Luce, Forward, Hamilton & Scripps LLP  
11988 El Camino Real, Suite 200  
San Diego, California 92130

by e-mail and First Class Mail, postage prepaid, this 12th day of June, 2008.

  
Cathay Y. N. Smith